

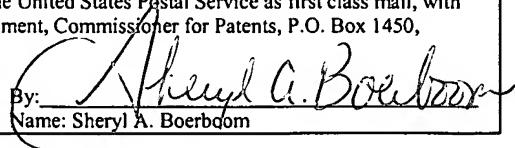


IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: PERSON HEI ET AL. Examiner: E. MCAVOY
Serial No.: 10/614,474 Group Art Unit: 1764
Filed: JULY 7, 2003 Docket: 163.1404USC2
Confirmation No.: 7611 Customer No.: 23552
Title: CONVEYOR LUBRICANT, PASSIVATION OF A THERMOPLASTIC CONTAINER TO STRESS CRACKING AND THERMOPLASTIC STRESS CRACK INHIBITOR

CERTIFICATE UNDER 37 CFR 1.8:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on March 7, 2005.

By: 
Name: Sheryl A. Boerboom

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

23552
PATENT TRADEMARK OFFICE

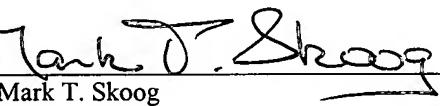
Sir:

We are transmitting herewith the attached:

- Transmittal Sheet in duplicate containing Certificate of Mailing
- Supplemental Information Disclosure Statement, Form 1449, 72 References
- Submission Pursuant to MPEP § 2207
- Return postcard

Please consider this a PETITION FOR EXTENSION OF TIME for a sufficient number of months to enter these papers or any future reply, if appropriate. Please charge any additional fees or credit overpayment to Deposit Account No. 13-2725. A duplicate of this sheet is enclosed.

MERCHANT & GOULD P.C.
P.O. Box 2903, Minneapolis, MN 55402-0903
612.332.5300

By: 
Name: Mark T. Skoog
Reg. No.: 40,178
MSkoog:sab



N 10/614,474

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | | |
|-------------------|--|-----------------|--------------|
| Applicant: | PERSON HEI ET AL. | Examiner: | E. MCAVOY |
| Serial No.: | 10/614,474 | Group Art Unit: | 1764 |
| Filed: | JULY 7, 2003 | Docket No.: | 163.1404USC2 |
| Confirmation No.: | 7611 | Customer No.: | 23552 |
| Title: | CONVEYOR LUBRICANT, PASSIVATION OF A THERMOPLASTIC CONTAINER TO STRESS CRACKING AND THERMOPLASTIC STRESS CRACK INHIBITOR | | |

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By: 
Name: Sheryl A. Boerboom

SUBMISSION PURSUANT TO MPEP § 2207

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to MPEP § 2207, enclosed are copies of:

1. A Memorandum, Opinion and Order dated May 29, 2003 from the U.S. District Court, District of Minnesota in litigation captioned Ecolab, Inc. v. JohnsonDiversey, Inc., Case No. 0:03-cv-02231, and
2. An Opinion dated April 6, 2004 from the Court of Appeals for the Federal Circuit in the same litigation.

Entry of these copies in the patent file is requested. As required by MPEP § 2207, this submission is being provided without additional comment. No fee is believed to be due in

connection with this Submission. If any fee is deemed to be due, please charge the fee to
Deposit No. 13-2725.

Respectfully submitted,

MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, Minnesota 55402-0903
(612) 332-5300

Date: Mar 7, 2005

Mark T. Skoog

Mark T. Skoog
Reg. No. 40,178
MTSkoog:sab





S/N 10/614,474

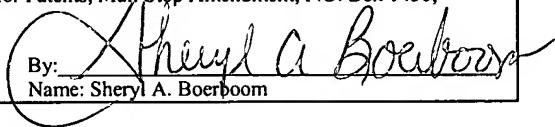
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | | |
|-------------------|--|-----------------|--------------|
| Applicant: | PERSON HEI ET AL. | Examiner: | UNKNOWN |
| Serial No.: | 10/614,474 | Group Art Unit: | 1764 |
| Filed: | JULY 7, 2003 | Docket No.: | 163.1404USC2 |
| Confirmation No.: | 7611 | Customer No.: | 23552 |
| Title: | CONVEYOR LUBRICANT, PASSIVATION OF A THERMOPLASTIC CONTAINER TO STRESS CRACKING AND THERMOPLASTIC STRESS CRACK INHIBITOR | | |

CERTIFICATE UNDER 37 CFR 1.8:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, with sufficient postage, in an envelope addressed to: Commissioner for Patents, Mail Stop Amendment, P.O. Box 1450, Alexandria, VA 22313-1450 on March 7, 2005.

By: 
Name: Sheryl A. Boerboom

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT
(37 C.F.R. § 1.97(b))

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

With regard to the above-identified application, the items of information listed on the enclosed Form 1449 are brought to the attention of the Examiner.

This statement should be considered because it is submitted before the mailing date of a first Office Action on-the-merits. Accordingly, no fee is due for consideration of the items listed on the enclosed Form 1449.

A copy of any foreign patent document or "Other Document" listed on the Form 1449 is enclosed, in accordance with 37 C.F.R. §1.98(a)(2). Because this application was filed after June 30, 2003, copies of the U.S. Patents and U.S. patent publications listed on the enclosed Form 1449 are not provided.

This Supplemental Information Disclosure Statement encloses a number of litigation documents. U.S. Patent No. 6,743,758 B2 (the "758 patent") and U.S. Patent No. 6,495,494 B1 (the "494 patent", a great grandparent to the present application), both assigned to Ecolab, are

currently the subject of pending litigation in the U.S. District Court, District of Minnesota. The litigation is captioned Ecolab, Inc. v. JohnsonDiversey, Inc., Case No. 0:03-cv-02231. Plaintiff Ecolab commenced the litigation by asserting infringement of the '494 patent in a Complaint filed March 7, 2003, followed by a Motion for Preliminary Injunction filed March 28, 2003. Defendant JohnsonDiversey, Inc. ("JohnsonDiversey") filed a number of memoranda and declarations in response, and cited several patents and other documents as allegedly invalidating the '494 patent. The District Court issued a Memorandum, Opinion and Order on May 29, 2003 ("District Court Decision") denying Ecolab's Motion for Preliminary Injunction, based at least in part on the District Court's construction of the phrase "water-miscible lubricant". The Court of Appeals for the Federal Circuit issued a decision on April 6, 2004 ("Federal Circuit Opinion") reversing the District Court Decision. The litigation is presently in the discovery stage.

The '758 patent issued on June 1, 2004. Ecolab amended its Complaint to assert infringement of the '758 patent on June 10, 2004.

JohnsonDiversey filed an Answer and Counterclaim to Plaintiff's Amended Complaint ("Counterclaim") on July 2, 2004. The Counterclaim alleged, *inter alia*, that the '758 patent was unenforceable due to inequitable conduct by the prosecuting attorney and others for failure in the application leading to the '758 patent to submit or to provide the certain papers not included in a Supplemental Information Disclosure Statement in that application. Ecolab believes that JohnsonDiversey's inequitable conduct allegation is improper, and are opposing it. Meanwhile pursuant to the first paragraph of MPEP §2001.06(c), applicants are bringing JohnsonDiversey's inequitable conduct allegation to the Examiner's attention.

Further, should the Examiner request it, Applicants can file an Information Disclosure Statement including any other references provided during prosecution of the application leading to the '758 patent.

This SIDS includes copies of the District Court and Federal Circuit Docket sheets, District Court Decision, Federal Circuit Opinion and various other court papers and exhibits from the litigation. Particulars concerning JohnsonDiversey's inequitable conduct allegation may be found, for example, in paragraphs 72 through 173 of the Counterclaim. A list of allegedly withheld material information may be found in paragraph 144. Assertions that applicants did not advise the USPTO of a dispute over the meaning of the phrase "water-miscible lubricant" may be found in paragraphs 159 through 173.

To further assist the Examiner, the dates of the court papers and exhibits enclosed with this SIDS (and the dates of other exhibits not enclosed with this SIDS but submitted in the application leading to the '758 patent are as follows:

| Item No. | Item | Asserted Date, if known | Date Submitted to USPTO |
|-----------------|---|---|--------------------------------|
| 1. | Docket Sheet for U.S. District Court, District of Minnesota, <u>Ecolab, Inc. v. JohnsonDiversey Inc.</u> , Case No. 0:03-cv-02231 | October 25, 2004 | Herewith. |
| 2. | Docket Sheet for U.S. Court of Appeals for the Federal Circuit, <u>Ecolab, Inc. v. JohnsonDiversey Inc.</u> , Case No.: 0:03-cv-02231 | October 25, 2004 | Herewith. |
| 3. | Complaint | March 7, 2003 | Herewith. |
| 3-A. | U.S. Patent No. 6,495,494 B1 (Exhibit A to Item No. 3) | December 17, 2002 (filed June 16, 2000) | Herewith. |
| 4. | Ecolab's Memorandum of Law in Support of Its Motion for a Preliminary Injunction | March 28, 2003 | Herewith. |
| 5. | Declaration of Tom Arata | March 28, 2003 | Herewith. |
| 6. | Declaration of David Cleveland | March 28, 2003 | Herewith. |
| 6-A. | U.S. Patent No. 6,495,494 B1 (Exhibit A to Item No. 6) | December 17, 2002 (filed June 16, 2000) | Herewith. |
| 6-B. | PCT Published Application No. WO 01/12759 A2 (Exhibit B to Item No. 6) | February 22, 2002 | Herewith. |
| 6-C. | Opinion Letter (Exhibit C to Item No. 6) | March 25, 2003 | Herewith. |
| 6-C-A. | U.S. Patent No. 6,495,494 B1 (Exhibit A to Item No. 6) | December 17, 2002 (filed June 16, 2000) | Herewith. |
| 6-C-B. | Ecolab Analytical & Physical Chemistry Analysis Report (Attachment B to Item No. 6-C) | February 4, 2003 | Herewith. |
| 6-C-C. | Product Information Sheet for DOWANOL DPM (Attachment C to Item No. 6-C) | August 2001 | Herewith. |

| Item No. | Item | Asserted Date, if known | Date Submitted to USPTO |
|-----------------|---|--------------------------------|--------------------------------|
| 6-C-D. | DICOLUBE TPB (JohnsonDiversey Product Information, Attachment D to Item No. 6-C) | 2002 or 2003 | Herewith. |
| 6-C-E. | DICOLUBE TPB Material Safety Data Sheet (Attachment E to Item No. 6-C) | June 20, 2002 | Herewith. |
| 6-C-F. | Lubricity Properties of DPM (Attachment F to Item No. 6-C) | 2003 | Herewith. |
| 6-D. | Dicolube System Dicolube TPB (Exhibit D to Item No. 6) | 2002 or 2003 | Herewith. |
| 7. | Declaration of Amy McBroom | March 28, 2003 | Herewith. |
| 7-A. | Product Information Sheet for DOWANOL DPM (Exhibit A to Item No. 7) | August 2001 | Herewith. |
| 7-B. | Ecolab Analytical & Physical Chemistry Analysis Report (Exhibit B to Item No. 7) | September 5, 2000 | Herewith. |
| 7-C. | Dicolube TPB (JohnsonDiversey Product Information, Exhibit C to Item No. 7) | 2002 or 2003 | Herewith. |
| 7-D. | Ecolab Analytical & Physical Chemistry Analysis Report (Exhibit D to Item No. 7) | February 4, 2003 | Herewith. |
| 7-E. | DICOLUBE TPB Material Safety Data Sheet (Exhibit E to Item No. 7) | June 20, 2002 | Herewith. |
| 7-F. | Lubricity Properties of DPM (Exhibit F to Item No. 7) | 2003 | Herewith. |
| 8. | Declaration of Rachel Zimmerman | March 28, 2003 | Herewith. |
| 8-A. | JohnsonDiversey Form 8-K | March 25, 2003 | Herewith. |
| 9. | Answer and Counterclaim | April 8, 2003 | Herewith. |
| 10. | JohnsonDiversey's Memorandum of Law in Opposition to Ecolab's Motion for a Preliminary Injunction | April 25, 2003 | Herewith. |
| 11. | Declaration of Tim A. Osswald | April 25, 2003 | Herewith. |
| 11-A. | Curriculum Vitae, Tim Andreas Osswald (Exhibit A to Item No. 11) | 2003 | Herewith. |
| 11-B. | T. Osswald's Prior Testimony (Exhibit B to Item No. 11) | 2002 or 2003 | Herewith. |

| Item No. | Item | Asserted Date, if known | Date Submitted to USPTO |
|-----------------|---|--------------------------------|--------------------------------|
| 11-C. | DOWANOL DPM (Exhibit C to Item No. 11) | April 13, 2003 | Herewith. |
| 11-D. | Dicolube TPB (JohnsonDiversey Product Information, Exhibit D to Item No. 11) | 2002 or 2003 | Herewith. |
| 11-E. | DICOLUBE TPB Material Safety Data Sheet (Exhibit E to Item No. 11) | June 20, 2002 | Herewith. |
| 12. | Declaration of Dr. Harriet Black Nemhard | April 25, 2003 | Herewith. |
| 12-A. | Minitab Output of Descriptive Statistics and Confidence Intervals on COF Data for Water, 67 ppm DPM, and 133 ppm DPM (Exhibit A to Item No. 12) | 2003 | Herewith. |
| 13. | Declaration of Jacques Rouillard ¹ | April 25, 2003 | Herewith. |
| 13-A. | Product Information Sheet for DOWANOL DPM (Exhibit A to Item No. 13) | August 2001 | Herewith. |
| 13-B. | Report for Project A-258, M. Stanga, Diversey S.p.A. (Exhibit B to Item No. 13) | December 1996 | Herewith. |
| 13-C. | Report for Project A-260, M. Stanga, F. Bruschi, G. Bonaldi (Exhibit C to Item No. 13) | September 1997 | Herewith. |
| 13-D. | Revised List of Conveyor Lubricants Compatible with PET Containers (Exhibit D to Item No. 13) | April 10, 1986 | Herewith. |
| 13-E. | “Continuous improvement...the essence of success”, <i>Quality Control Corner, Beverage World</i> (Exhibit E to Item No. 13) | July 1996 | Herewith. |
| 13-F. | Testing Protocol (Exhibit F to Item No. 13) | Believed to be 2003 | Herewith. |
| 14. | Declaration of Keith W. Kennedy | April 24, 2003 | Herewith. |

¹ Pages 11-13 in the Rouillard Declaration provide observations about U.S. Patent Nos. 4,420,578, 5,139,834, 5,174,914, 5,559,087 and 5,925,601. The patents are listed on the accompanying Form 1449.

| Item No. | Item | Asserted Date, if known | Date Submitted to USPTO |
|-----------------|--|---|--|
| 14-A. | DiverseyLever Core-Euro Formulation (Exhibit A to Item No. 14) | July 1, 2000 | Herewith. |
| 14-B. | JohnsonDiversey Food Group Duplicate Invoice for Dicolube TP (Exhibit B to Item No. 14) | May 9, 1996 | Herewith. |
| 14-C. | Material Safety Data Sheet for Dicolube TP (Exhibit C to Item No. 14) | April 11, 1996 | Herewith. |
| 14-D. | Report for Project A-260, M. Stanga, F. Bruschi, G. Bonaldi (Exhibit D to Item No. 14) | September 1997 | Herewith. |
| 14-E. | Track Treatment Workshop, Alzey, Germany (Exhibit E to Item No. 14) | March 31, 1998 - April 1, 1998 | Herewith. |
| 15. | Declaration of Michael K. Lammers | April 25, 2003 | Herewith. |
| 15-A. | Dicolube TPB Sales (Exhibit A to Item No. 15) | April, 2003 | Herewith. |
| 16. | Declaration of Christopher G. Hanewicz | April 25, 2003 | Herewith. |
| 16-A. | Table of Anticipatory Prior Art (Appendix A to Item No. 16) | 2003 | Herewith. |
| 16-B. | Invalidity Analysis of Claims 4, 7, 9, 14-19, 24, 27 and 30-32 (Appendix B to Item No. 16) | 2003 | Herewith. |
| 16-C. | U.S. Patent No. 6,495,494 B1 (Exhibit C to Item No. 16) | December 17, 2002 (filed June 16, 2000) | Not submitted (great grandparent patent in suit) |
| 16-D. | U.S. Patent No. 4,420,578 (Exhibit D to Item No. 16) | December 13, 1983 (filed September 14, 1981) | Herewith. |
| 16-E. | U.S. Patent No. 5,139,834 (Exhibit E to Item No. 16) | August 18, 1992 (parent filed October 29, 1980) | Herewith. |
| 16-F. | U.S. Patent No. 5,043,380 (Exhibit F to Item No. 16) | August 27, 1992 (filed October 29, 1980) | Herewith. |
| 16-G. | U.S. Patent No. 5,174,914 (Exhibit G to Item No. 16) | December 29, 1992 (filed June 16, 1991) | Herewith. |
| 16-H. | U.S. Patent No. 5,559,087 (Exhibit H to Item No. 16) | September 24, 1996 (filed June 28, 1994) | Herewith. |
| 16-I. | U.S. Patent No. 5,925,601 (Exhibit I to Item No. 16) | July 20, 1999 (filed October 13, 1998) | Herewith. |
| 16-J. | U.S. Patent No. 5,935,914 (Exhibit J to Item No. 16) | August 10, 1999 (filed October 15, 1997) | Herewith. |

| Item No. | Item | Asserted Date, if known | Date Submitted to USPTO |
|-----------------|--|---|--------------------------------|
| 16-K. | U.S. Patent No. 5,747,431 (Exhibit K to Item No. 16) | May 5, 1998 (filed February 3, 1997) | Herewith. |
| 16-L. | U.S. Patent No. 5,202,037 (Exhibit L to Item No. 16) | April 13, 1993 (filed October 2, 1989) | Herewith. |
| 16-M. | U.S. Patent No. 4,769,162 (Exhibit M to Item No. 16) | September 6, 1988 (filed June 12, 1987) | Herewith. |
| 16-N. | U.S. Patent No. 5,391,308 (Exhibit N to Item No. 16) | February 21, 1995 (filed March 8, 1993) | Herewith. |
| 16-O. | U.S. Patent No. 5,062,979 (Exhibit O to Item No. 16) | November 5, 1991 (filed September 13, 1989) | Herewith. |
| 16-P. | European Patent Application EP 99305796.7 (Exhibit P to Item No. 16) | Not yet published ² | Herewith. |
| 17. | Ecolab's Reply Memorandum of Law in Support of Its Motion for a Preliminary Injunction | May 5, 2003 | Herewith. |
| 18. | Reply Declaration of Tom Arata | May 2, 2003 | Herewith. |
| 19. | Second Declaration of David R. Cleveland | May 4, 2003 | Herewith. |
| 19-A. | April 17, 2001 SIDS in the '599 application (Exhibit A to Item No. 19) | April 17, 2001 | Herewith. |
| 19-B. | U.S. Patent No. 4,062,785 (Exhibit B to Item No. 19) | December 13, 1977 (filed February 23, 1976) | Herewith. |
| 19-C. | U.S. Patent No. 4,709,806 (Exhibit C to Item No. 19) | December 1, 1987 (parent filed July 13, 1984) | Herewith. |
| 19-D. | U.S. Patent No. 5,427,258 (Exhibit D to Item No. 19) | June 27, 1995 (filed March 26, 1993) | Herewith. |
| 20. | Reply Declaration of Thomas J. Hairston, Ph.D. | May 2, 2003 | Herewith. |
| 20-A. | Curriculum Vitae, Thomas J. Hairston, Ph.D. (Exhibit E to Item No. 20) | 2003 | Herewith. |
| 21. | Reply Declaration of Amy McBroom | May 2, 2003 | Herewith. |
| 22. | Declaration of Mario Stanga | May 9, 2003 | Herewith. |

² According to the European Patent Office's Online Public File Inspection service at <http://ofi.epoline.org/view/GetDossier?dosnum=&lang=EN> this application has not yet published.

| Item No. | Item | Asserted Date, if known | Date Submitted to USPTO |
|-----------------|--|---|--------------------------------|
| 22-1. | Graph I BIS ((Exhibit 1 to Item No. 22) | September 1997 | Herewith. |
| 23. | Declaration of Mark Kassel ³ | May 15, 2003 | Herewith. |
| 23-A. | Curriculum Vitae, Mark A. Kassel (Exhibit A to Item No. 23) | | Herewith. |
| 23-B. | Claim Chart (Exhibit B to Item No. 23) | 2003 | Herewith. |
| 23-C. | Technical Bulletin MAZU® DF210 S 10% Silicone Defoamer (Exhibit C to Item No. 23) | 2002 | Herewith. |
| 23-D. | U.S. Patent No. 6,060,444 (Exhibit C to Item No. 23) | May 9, 2000 (grandparent filed December 30, 1993) | Herewith. |
| 23-E. | 1520 Silicone Antifoam Brochure, <i>Dow Corning Webpage</i> (Exhibit E to Item No. 23) | May 2003 | Herewith. |
| 23-F. | U.S. Patent No. 6,087,308 (Exhibit F to Item No. 23) | July 11, 2000 (filed December 22, 1998) | Herewith. |
| 23-G. | U.S. Patent No. 5,062,979 (Exhibit G to Item No. 23) | November 5, 1991 (filed September 13, 1989) | Herewith. |
| 23-H. | U.S. Patent Application No. 09/619,261 (Exhibit H to Item No. 23) | July 19, 2000 | Herewith. |
| 24. | Third Declaration of David R. Cleveland | May 23, 2003 | Herewith. |
| 25. | District Court Decision | May 29, 2003 | Herewith. |
| 26. | Ecolab's Appeal Brief | August 11, 2003 | Herewith. |
| 27. | JohnsonDiversey's Appeal Brief | September 22, 2003 | Herewith. |
| 28. | Ecolab's Reply Brief | October 23, 2003 | Herewith. |
| 29. | Federal Circuit Opinion | April 6, 2004 | Herewith. |
| 30. | Ecolab's Amended Complaint | June 10, 2004 | Herewith. |

³ Page 28 (see numbered paragraph 61) in the Kassel Declaration refers to U.S. Patent Nos. 5,559,087, 5,174,914, "5,952,601" (believed to be a reference to U.S. Patent No. 5,925,601, as U.S. Patent No. 5,952,601 is entitled "RECOILLESS AND GAS-FREE PROJECTILE PROPULSION"), 6,087,308, 4,062,785 and 5,062,979. Page 29 (see numbered paragraph 62) in the Kassel Declaration refers to U.S. Patent Nos. 4,420,578, 5,043,380, 5,139,834, 5,174,914, 5,559,087, 5,925,601, 4,062,785, 6,060,444 and 6,087,308. These patents are listed on the Form 1449 submitted herewith.

| Item No. | Item | Asserted Date, if known | Date Submitted to USPTO |
|-----------------|---|--|--------------------------------|
| 30-A. | U.S. Patent No. 6,495,494 B1 (Exhibit A to Item No. 30) | December 17, 2002 (filed June 16, 2000) | Herewith. |
| 30-B. | U.S. Patent No. 6,673,753 B2 (Exhibit B to Item No. 30) | January 6, 2004 (parent filed June 16, 2000) | Herewith. |
| 30-C. | U.S. Patent No. 6,743,758 B2 (Exhibit C to Item No. 30) | June 1, 2004 (parent filed June 16, 2000) | Herewith. |
| 31. | JohnsonDiversey's Answer and Counterclaim to Ecolab's Amended Complaint | July 2, 2004 | Herewith. |
| 32. | Ecolab's Reply to JohnsonDiversey's Counterclaim | August 11, 2004 | Herewith. |

Many of the items referred to above are dated after the August 16, 1999 and/or June 16, 2000 effective filing dates, for the present application.

None of the items referred to above are believed to identify with particularity any assertions made by applicants in the litigation that would be contradictory to assertions made by applicants to the Examiner responsible for the '494 patent and '758 patent. Applicants do not believe they have made any such contradictory assertions.

As to some of the remaining items referred to above:

- a) Item Nos. 13-B and 13-C are both believed to be unpublished Diversey S.p.A., JohnsonDiversey, Inc. or DiverseyLever, Inc. company documents (see e.g., the Rouillard Declaration, Item No. 13, numbered paragraph 12 at pages 4-5).
- b) Item No. 13-D is believed to be an unpublished South Eastern Containers Corp., JohnsonDiversey, Inc. or DiverseyLever, Inc. company document (see e.g., the Rouillard Declaration, Item No. 13, numbered paragraph 14 at page 5).
- c) Dicolube TP has been alleged by JohnsonDiversey to have been offered for sale in the U.S. prior to June 16, 2000 but is believed not to have contained both a water-miscible silicone material and a water-miscible lubricant (see e.g., the Kennedy Declaration, Item No. 14, numbered paragraphs 9 and 12-14 at pages 3-4 and Item Nos. 14-A through 14-C).
- d) Dicolube TPB has been alleged by JohnsonDiversey to have been offered for sale in Europe prior to June 16, 2000 but is not believed to have been known or used by others in the U.S., patented or described in a printed publication in this or a

- foreign country, or in public use or on sale in the U.S. prior to June 16, 2000 (see e.g., the Kennedy Declaration, Item No. 14, numbered paragraphs 6-12 and 16-19 at pages 2-5).
- e) Item No. 14-D is believed to be an unpublished Diversey S.p.A., JohnsonDiversey, Inc. or DiverseyLever, Inc. company document (see e.g., the Kennedy Declaration, Item No. 14, numbered paragraphs 16-18 at pages 4-5).
 - f) Item No. 14-E is believed to be an unpublished DiverseyLever, Inc. internal workshop presentation made in Germany (see e.g., the Kennedy Declaration, Item No. 14, numbered paragraph 19 at page 5).
 - g) Item No. 16-P is believed to be an unpublished European Patent Application (see the European Patent Office's Online Public File Inspection service at <http://ofi.epoline.org/view/GetDossier?dosnum=&lane=EN>).
 - h) Item no. 22-1 is believed to be an unpublished Diversey S.p.A. company document (see e.g., the Stanga Declaration, Item No. 22, numbered paragraph 9 at pages 4-5).

The District Court Decision and Federal Circuit Opinion are being separately submitted under MPEP §2207, so that they can be placed in the patent file in any event. If desired by the Examiner, applicants can provide copies of any of the other papers filed in the litigation (e.g., interrogatories and responses, deposition transcripts, and the like) and not already included with this Supplemental Information Disclosure Statement, subject to applicable confidentiality restrictions. The Examiner is also invited to contact Applicants' Representative at the below-listed telephone number, if there are any questions regarding this Supplemental Information Disclosure Statement or if any other assistance is needed during prosecution of the present application.

No representation is made that a reference is "prior art" within the meaning of 35 U.S.C. §§ 102 and 103 and Applicants reserve the right, pursuant to 37 C.F.R. § 1.131 or otherwise, to establish that the reference(s) are not "prior art." Moreover, Applicants do not represent that a reference has been thoroughly reviewed or that any relevance of any portion of a reference is intended.

Consideration of the items listed is respectfully requested. Pursuant to the provisions of M.P.E.P. 609, it is requested that the Examiner return a copy of the attached Form 1449, marked

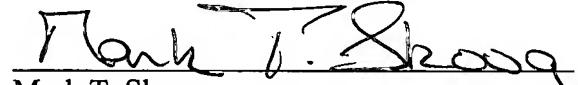
as being considered and initialed by the Examiner, to the undersigned with the next official communication.

Please charge any additional fees or credit any overpayment to Deposit Account No. 13-2725.

Respectfully submitted,

MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, Minnesota 55402-0903
(612) 332-5300

Date: Mar 7, 2005


Mark T. Skoog
Reg. No. 40,178
MTSkoog:sab

23552

PATENT TRADEMARK OFFICE

| | | | |
|--|--|--------------------------------|-----------------------------------|
| FORM 1449* | | Docket Number: 163.1404USC2 | Application Number: 10/614,474 |
| INFORMATION DISCLOSURE STATEMENT IN AN APPLICATION (Use several sheets if necessary) | | Applicant: HEI ET AL. | |
| | | Filing Date: JULY 7, 2003 | Group Art Unit: 1764 |
| | | Customer No.: 23552 | |

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| | Docket Sheet for U.S. District Court, District of Minnesota, <u>Ecolab, Inc. v. JohnsonDiversey Inc.</u> , Case No. 0:03-cv-02231, October 25, 2004 |
| | Docket Sheet for U.S. Court of Appeals for the Federal Circuit, <u>Ecolab, Inc. v. JohnsonDiversey Inc.</u> , Case No.: 0:03-cv-02231, October 25, 2004 |
| | Complaint, U.S. District Court, District of Minnesota, <u>Ecolab, Inc. v. JohnsonDiversey Inc.</u> , Case No. 0:03-cv-02231 March 7, 2003 |
| | Ecolab's Memorandum of Law in Support of Its Motion for a Preliminary Injunction, March 28, 2003 |
| | Declaration of Tom Arata, March 28, 2003 |
| | Declaration of David Cleveland, March 28, 2003 |
| | Opinion Letter (Exhibit C to Item No. 6), March 25, 2003 |
| | Ecolab Analytical & Physical Chemistry Analysis Report (Attachment B to Item No. 6-C), February 4, 2003 |
| | Product Information Sheet for DOWANOL DPM (Attachment C to Item No. 6-C), August 2001 |
| | Dicolube TPB (JohnsonDiversey Product Information, Attachment D to Item No. 6-C), 2002 or 2003 |
| | DICOLUBE TPB Material Safety Data Sheet (Attachment E to Item No. 6-C), June 20, 2002 |
| | Lubricity Properties of DPM (Attachment F to Item No. 6-C), 2003 |
| | Dicolube System Dicolube TPB (Exhibit D to Item No. 6), 2002 or 2003 |
| | Declaration of Amy McBroom, March 28, 2003 |
| | Product Information Sheet for DOWANOL DPM (Exhibit A to Item No. 7), August 2001 |
| | Ecolab Analytical & Physical Chemistry Analysis Report (Exhibit B to Item No. 7), September 5, 2000 |
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| | DICOLUBE TPB Material Safety Data Sheet (Exhibit B to Item No. 7), June 20, 2002 |
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| | Declaration of Rachel Zimmerman, March 28, 2003 |
| | JohnsonDiversey Form 8-K, March 25, 2003 |
| | Answer and Counterclaim, U.S. District Court, District of Minnesota, <u>Ecolab, Inc. v. JohnsonDiversey, Inc.</u> , Case No. 0:03-cv-02231, April 8, 2003 |
| | JohnsonDiversey's Memorandum of Law in Opposition to Ecolab's Motion for a Preliminary Injunction, April 25, 2003 |
| | Declaration of Tim A. Osswald, April 25, 2003 |
| | Curriculum Vitae, Tim Andreas Osswald (Exhibit A to Item No. 11), 2003 |
| | T. Osswald's Prior Testimony (Exhibit B to Item No. 11), 2002 or 2003 |
| | DOWANOL DPM (Exhibit C to Item No. 11), April 13, 2003 |
| | Dicolube TPB (JohnsonDiversey Product Information, Exhibit D to Item No. 11), 2002 or 2003 |
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| | Minitab Output of Descriptive Statistics and Confidence Intervals on COF Data for Water, 67 ppm DPM, and 133 ppm DPM (Exhibit A to Item No. 12), 2003 |
| | Declaration of Jacques Rouillard, April 25, 2003 |
| | Product Information Sheet for DOWANOL DPM (Exhibit A to Item No. 13), August 2001 |
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| | Revised List of Conveyor Lubricants Compatible with PET Containers (Exhibit D to Item No. 13), April 10, 1986 |

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| | Declaration of Keith W. Kennedy, April 24, 2003 |
| | Report for Project A-260, M. Stanga, F. Bruschi, G. Bonaldi, September 1997 (Exhibit D to Item No. 14) |
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| | Declaration of Michael K. Lammers, April 25, 2003 |
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| | Invalidity Analysis of Claims 4, 7, 9, 14-19, 24, 27 and 30-32 (Appendix B to Item No. 16), 2003 |
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| | Reply Declaration of Thomas J. Hairston, Ph.D., May 2, 2003 |
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| | Graph I BIS ((Exhibit I to Item No. 22), September 1997 |
| | Declaration of Mark Kassel, May 15, 2003 |
| | Curriculum Vitae, Mark A. Kassel (Exhibit A to Item No. 23) |
| | Claim Chart (Exhibit B to Item No. 23), 2003 |
| | 1520 Silicone Antifoam Brochure, <i>Dow Corning Webpage</i> (Exhibit E to Item No. 23), May 2003 |

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| | Ecolab's Reply to JohnsonDiversey's Counterclaim, U.S. District Court, District of Minnesota, <u>Ecolab, Inc. v. JohnsonDiversey Inc.</u> , Case No.: 0:03-cv-02231, August 11, 2004 |



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